



PATENT PROTECTION FOR HIGH TECHNOLOGY

Elena B. Dreszer (408) 278-4052 - Direct Dial
edreszer@slwip.com

John D. Gustav-Wrathall (612) 371-2130 - Direct Dial
jwrathall@slwip.com

January 26, 2012

Re: OpenTV, Inc. Ref. No. OPTV-001/REI/US - SLW Ref. No. 2050.001US3
U.S. Patent Application Serial No.: 09/672,523
Title: METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM

Dear Ansley Jessup:

Enclosed is a Substitute Reissue Declaration that must be executed to complete the filing requirements for the above-referenced patent application. Please review the document and then sign and date the document where indicated.

Please return a copy of the executed document to my attention before February 17, 2012. The document can be faxed to my attention at (612) 339-3061 or returned by mail.

If you have any questions regarding this matter, please contact Elena B. Dreszer at (408) 278-4052.

Sincerely,

Tara C. McMillen

Enclosure

SCHWEGMAN ■ LUNDBERG ■ WOESSNER

United States Patent Application

SUBSTITUTE REISSUE DECLARATION

As a below named inventor I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name;

I verily believe I am the original, first and joint inventor of the subject matter which is described and claimed in U.S. Patent No. 5,819,034 which was issued on October 6, 1998, and of the subject matter claimed in the broadening reissue patent application no. 09/672,523 filed on September 27, 2000 which reissue patent application corresponds to U.S. Patent No. 5,819,034, the specification of which was filed on September 27, 2000.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by the amendments filed on: October 31, 2000; April 13, 2001; April 29, 2002; September 4, 2002; February 27, 2003; March 18, 2003; November 10, 2003; December 15, 2003; October 6, 2004; May 2, 2005; August 6, 2007; May 29, 2008; and March 30, 2009.

I believe original patent 5,819,034 ("the '034 patent"), to be wholly or partly inoperative by reason of my claiming less than I had the right to claim in the patent. The claims of the '034 patent relate to a distributed computer system. For example, claim 1 recites a distributed computer system reciting, inter alia, a "further processor including means to . . . form an interactive video program in which execution of said distributed computing application alters said video program." However, the '034 patent also discloses a method and system that, stated generally, facilitate the presenting of data about an item being offered for sale to a user, and in response to a single action by the user, generating an order for the item. This invention is distinct from the invention claimed in the original patent; and is not in any way claimed in the issued claims of the '034 patent. The above quoted language of issued claim 1 is not necessary for patentability of claims drawn to the identified disclosed but unclaimed invention, and thus the presence of this limitation renders the '034 patent partly inoperative. This error is addressed in this reissue by eliminating limitations found in the issued claims, including the limitation from issued claim 1 of the '034 patent quoted above, and by including claims directed to methods and systems of facilitating ordering an item, where the order is placed in response to a single action by the user. In particular, the error is addressed by the presentation of claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260 and 262, drawn to this previously unclaimed invention.

The error arose without any deceptive intention on my part. The error arose during the drafting of the application and during subsequent amendments in connection with the prosecution of the application which resulted in the issuance of the original patent. The error occurred as a result of the attorney prosecuting the application and I failing to appreciate the scope of the invention and/or to properly identify the invention(s). The error was discovered subsequent to issuance of the original patent during a review of the original patent by the assignee and/or its representatives. I further acknowledge my duty to disclose to the Office all information known to me to be material to patentability defined by 37 CFR §1.56.

I hereby appoint the attorneys associated with the customer number listed below to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith:

Customer Number: 44367

I hereby authorize them to act and rely on instructions from and communicate directly with the person/assignee/attorney/firm/organization/who/which first sends/sent this case to them and by whom/which I hereby declare that I have consented after full disclosure to be represented unless/until I instruct Schwegman, Lundberg & Woessner, P.A. to the contrary.

Please direct all correspondence in this case to **Schwegman, Lundberg & Woessner, P.A.** at the address indicated below:
Customer Number. 44367

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of joint inventor number 1 : **Kuriacose Joseph**
Citizenship: **United States of America**
Post Office Address: 16124 Orchard Grove Road
Gaithersburg, MD 20878

Residence: **Gaithersburg, MD**

Signature: _____
Kuriacose Joseph

Date: _____

Full Name of joint inventor number 2 : **Vincent Dureau**
Citizenship: **France**
Post Office Address: 3519 S. Court
Palo Alto, CA 94306

Residence: **Palo Alto, CA**

Signature: _____
Vincent Dureau

Date: _____

Full Name of joint inventor number 3 : **Alain Delpuch**
Citizenship: **France**
Post Office Address: 36 rue Le Brun
Paris 75013
France

Residence: **Paris, France**

Signature: _____
Alain Delpuch

Date: _____

Full Name of joint inventor number 4 : **Ansley Wayne Jessup**

Citizenship: **United States of America**

Residence: **Willingboro, NJ**

Post Office Address: 22 Elmwood Lane
Willingboro, NJ 08046

Signature: _____ Date: _____
Ansley Wayne Jessup

Every error in the patent which was corrected in the present reissue application, and which is not covered by the prior oath(s) and/or declaration (s) submitted in this application, arose without any deceptive intention on the part of the applicant.

§ 1.56 Duty to disclose information material to patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is canceled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is canceled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
 - (i) Opposing an argument of unpatentability relied on by the Office, or
 - (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) Each inventor named in the application;
- (2) Each attorney or agent who prepares or prosecutes the application; and
- (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.